

### **REMARKS/ARGUMENTS**

The final office action of July 17, 2007 has been carefully reviewed and these remarks are responsive thereto. Entry of the above amendments, reconsideration and allowance of the instant application are respectfully requested. Claims 7-12 and 19-30 remain in this application. No new matter has been added.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 7, 9, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. published application no. 20020133507 to Holenstein et al. (“Holenstein”) in view of U.S. patent 5806074 to Souder et al. (“Souder”). Claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein in view of Souder, and further in view of U.S. published application no. 20020191452 to Fujihara (“Fujihara”). Claims 10-12 and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein in view of Souder, and further in view of Brush, Gupta, Barger and Cadiz, “Robust Annotation Positioning in Digital Documents,” published 9/22/2000, Microsoft Corporation, Technical Report (referred to hereinafter as “Gupta” to be consistent with the office action). Claims 25 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein, in view of Souder, and in further view of U.S. patent 5588147 to Neeman et al. (“Neeman”). Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein in view of Souder, further in view of Neeman, and further in view of Fujihara. Claims 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein in view of Souder, further in view of Neeman, and further in view of Gupta. Applicants respectfully traverse these rejections.

Amended independent claim 25 recites, among other features, “wherein the collision criteria prohibits ink strokes from being removed from a leaf node below the pinned node.” Applicants note that this feature is similar to features previously recited in dependent claim 28. The February 1, 2007 office action at pages 6-7 concedes that the combination of Holenstein and Neeman fails to disclose features related to a collision criteria that prohibits ink strokes from being removed from a leaf node below a pinned node, relying on Gupta at pg. 7, paragraph [5.3.1], lines 5-8 and pg. 4, paragraph [3.2], line 12 to allegedly demonstrate the recited features.

The present office action (of mailing date July 17, 2007) at pages 5-6 concedes that Souder (in combination with Holenstein) fails to disclose the recited features as well, and relies on the same passages of Gupta to allegedly demonstrate the recited features. Applicants respectfully disagree that Gupta (or any of the other applied references, or any combination of the applied references, for that matter) teaches or suggests features related to collision criteria that prohibits ink strokes from being removed from a leaf node below a pinned node as recited in amended claim 25 (and previously recited in dependent claim 28). Applicants refer the Office to the Amendment of April 27, 2007 at page 10, and incorporate those remarks herein by way of reference (to the extent that they apply to the above noted features). For purposes of synchronizing those remarks with the present office action, Applicants note that the present office action at page 6, in footnote 5, again analogizes the anchor text of Gupta with the pinned node as claimed, based on an assertion that anchored text is unchangeable. Applicants once again note that Gupta at pg. 4, paragraph [3.2.2] describes using surrounding context in the event that anchor text information changes. Thus, the rationale/basis used by the Office to analogize the anchor text of Gupta to the pinned node is flawed for at least these reasons, because contrary to the Office's assertions, the anchor text information can change; it is not unchangeable as claimed.

The present office action at pages 14-15 states that Gupta was not relied upon to disclose the particular features; however, the present office action fails to identify where in the remaining references such teachings are present. Additionally, Applicants have demonstrated herein that both the February 1, 2007 office action (at pages 6-7) and the present office action (at pages 5-6) have relied on Gupta to allegedly demonstrate features related to the collision criteria prohibiting ink strokes from being removed from a leaf node below a pinned node because Holenstein, Souder and Neeman were deficient in this respect.

The present office action at pages 14-15 further states that: (1) in reference to the term "unchangeable", the features upon which the applicants rely are not recited in the rejected claim(s), and (2) that while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (citing *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). As already discussed, Applicants note that the Office's rejection is based on a proposed analogy between the anchor text in Gupta and the pinned node

as recited because, *according to the Office*, anchor text is unchangeable. Applicants remind the Office that prior art references must be read in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (VI. Prior Art Must Be Considered In Its Entirety, Including Disclosures That Teach Away From The Claims). Gupta at pg. 4, paragraph [3.2.2] clearly runs counter to the analogy between Gupta and the claim language that the Office has proposed, thus rendering the proposed analogy inappropriate. With respect to the Office's suggestion that the claim language cannot be read to include limitations (i.e., unchangeable) from the specification, Applicants refer the Office to paragraph [0218] of the published application, wherein it is stated that "[t]he software application 1701 may additionally *"pin"* existing electronic ink data 1705, *so as to prohibit its modification* by the analysis process." Emphasis added. Thus, Applicants submit that the holding of *In re Van Geuns* does not apply in this instance, because one is not required to read features/limitations from the specification into the claim language; rather, the unchangeable nature of a pinned (node) is inherent in the definition of what it means to be pinned. For the foregoing reasons, Applicants submit that notwithstanding whether any combination of the prior art references is appropriate, the proposed combination fails to result in at least the aforementioned features recited in amended claim 25. Claim 25 is allowable over the applied references for at least the foregoing reasons.

Amended independent claims 7 and 19 recite features similar to those described above with respect to claim 25. Thus, independent claims 7 and 19 are allowable for at least those same reasons.

The dependent claims are allowable for at least the same reasons as their respective base claims, and further in view of the additional advantageous features recited therein, because none of the remaining applied references cure the aforementioned deficiencies of the prior art as applied to the base claims.

For example, amended dependent claim 11 calls for, among other features, "prohibits a *parental status change* of leaf nodes below the pinned node." Gupta paragraph [5.1.1], lines 11-14 demonstrates if an algorithm can not find a location for an annotation, it orphans the annotation. Thus, the status change of an annotation in Gupta from parented to orphaned

represents a parental status change, and hence, does not teach or suggest “prohibits a parental status change” as recited in claim 11. In fact, the cited passages of Gupta teach away from the recited features. The remaining applied references fail to cure the above noted deficiencies of Gupta. Thus, notwithstanding whether any combination of applied references is proper, such combinations fail to result in at least these features as recited in claim 11. Claim 11 is allowable for at least this additional reason.

### **CONCLUSION**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,  
BANNER & WITCOFF, LTD.

Dated: August 27, 2007

By: /Gary D. Fedorochko/  
Gary D. Fedorochko  
Registration No. 35,509

1100 13<sup>th</sup> Street, N.W., Suite 1200  
Washington, D.C. 20005-4051  
Tel: (202) 824-3000  
Fax: (202) 824-3001  
GDF:lab